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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

574313-3359

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on _____

Signature _____

Typed or printed name _____

Application Number

10/544,281

Filed

8/3/2005

First Named Inventor

Quaranta

Art Unit

1616

Examiner

Sabiha Qazi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number _____

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 48,104

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8 November 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of 1 forms are submitted.

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

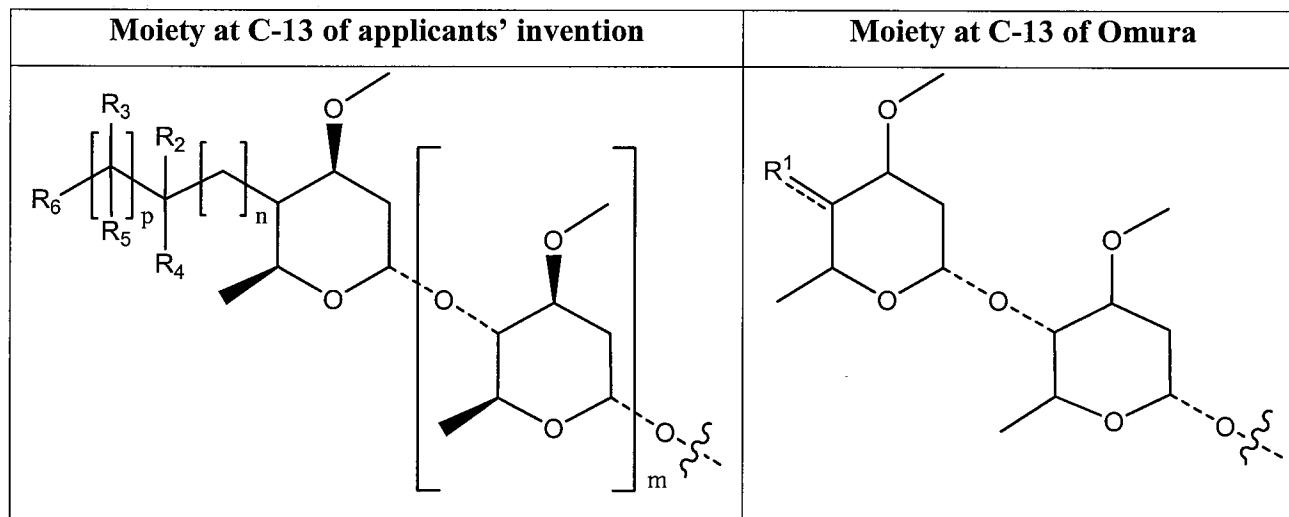
I. Status of claims

Claims 1-4 and 7-20 are pending in this application. There are no amendments after final to be considered.

II. There is a clear factual deficiency in the obviousness rejection based on Omura of applicants' claims which results in all claim limitations not being taught

A *prima facie* case of obviousness is not established if all claim limitations have not been taught or suggested by the cited reference. *See* MPEP 2143.03. For the pending claims, Omura does not teach or suggest all of the applicants' claim limitations. Moreover, this requirement applies to all pending claims not just the pending independent claims.

Both the applicants claims and Omura are directed toward avermectin-type compounds. However, Omura is directed toward a different type of avermectin derivative that that of the applicants', specifically the moieties attached to the hydroxy group at the C-13 position (see formula (I) in col. 1 of Omura) of the avermectin core structure are different - these moieties are presented below:



A. There is no "embracing" of applicants' claimed invention by Omura

The Omura rejection in the Office Action of 7 August 2007 began by stating:

"The reference teaches avermectin derivatives having high antiparasitic activity, which embraces Applicant's claimed invention. See entire document especially formula (I) and lines 1-67 in col. 1, lines 1-58 in column 2, preparation, Tables 1-8 in column 37-45 and claims

Instant claims differ from the reference in that they are of different generic scope.”

This assessment of Omura is in error as the scope of Omura is completely outside that of the applicants’ claimed invention.

A general reference to Omura’s compounds can be found on col. 1, line 34 through col. 2, line 58. One clear distinction between the Omura and the applicants’ claimed invention is that in Omura most of disclosure is directed for the situations where the bond between the saccharide and R¹ is a **double bond** (“...the line --- between R¹ and a carbon atom at the 4” position represents a double bond;” - see col. 1, lines 63-64, col 2, lines 24-25 and 48-49).

The link between the saccharide and the carbon atom in the applicants’ claimed invention is a **single bond**.

Omura does have a description for the situations where the link between R¹ and the saccharide is a single bond, but this description is extremely limited, i.e. encompasses only carboxymethyl (HOOC-CH₂-) and cyanomethyl (NC-CH₂-) - see col. 2, lines 40-42 (“...or when the line --- between R¹ and a carbon atom at the 4” position represents a single bond, R¹ may represent a carboxymethyl group or a cyanomethyl group.”).

However, both of these moieties are excluded from the scope of the applicants’ compounds by the proviso which is at the end of the applicants’ claim 1 (“...with the proviso, that the group R₆-[C(R₃)(R₅)]_p-C(R₂)(R₄)-[CH₂]_n-, which is attached to the ε-position of the compound of the formula (1), is not NC-CH₂- or HOOC-CH₂- when m is 1 and the bond between atoms 22 and 23 is a single bond.” (emphasis added)).

Therefore, there is no overlap between Omura and the applicants’ claimed invention.

Claims 2-4 and 7-20 are all ultimately dependent upon claim 1 and therefore, this factual deficiency applies to these claims as well.

B. Monosaccharide vs. Disaccharide (Claims 10, 13, 15 and 17)

In addition to the factual deficiency described above, claims 10, 13, 15 and 17 have a further factual deficiency, specifically recited that m = 0, i.e. the moiety at C-13 is a **monosaccharide** whereas in Omura, the moiety at C-13 is a **disaccharide**.

C. Alkyl chain is longer than a single CH₂ group (Claims 11-13, 17, 18 and 20)

In addition to the factual deficiency described in A. above, the alkyl chains in claims 11-13, 17, 18 and 20 are longer than the single CH₂ referred to in Omura. Claims 12 and 13 require at least a two carbon chain and claims 11, 17, 18 and 20 require at least a three carbon chain. Moreover, claims 17, 18 and 20 describe at least a (R₆)(R₅)C=C(R₄)-CH₂- moiety, i.e. includes and alkene group.

D. Omura does not teach a comparable hydroxy moiety (Claim 19)

In addition to the factual deficiency described in A. above, applicants claim 19 describes compounds where the 4" substitution is either HO-CH₂- or HO-CH₂-CH₂- which is not described by Omura.

For any of the above reasons, the rejection over Omura is in error and should be withdrawn.

Respectfully submitted,
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